

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | Art Unit: 1645 |
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| NIELSEN, Jan Clair |) | Examiner: GANGLE, B. |
| |) | |
| Serial No.: 10/562,421 |) | Washington, D.C. |
| |) | |
| Filed: May 17, 2006 |) | October 15, 2009 |
| |) | |
| For: INITIATION OF |) | Docket No.: NIELSEN=6A |
| FERMENTATION |) | |
| |) | Confirmation No.: 5536 |

PETITION AGAINST RESTRICTION UNDER 37 CFR 1.144 AND
CONDITIONAL PETITION TO VACATE AND WITHDRAW FINALITY
UNDER 37 CFR 1.181

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

S i r :

1. Petition Against Restriction

Pursuant to 37 CFR 1.144, Applicants hereby petition against the restriction made June 23, 2008, which was traversed September 23, 2008, and made final January 7, 2009. A further request for reconsideration was made May 4, 2009, but the restriction was maintained by the August 13, 2009 final action. No appeal has yet been filed so this petition is timely.

This is the national stage of a PCT application, so PCT unity rules apply. The original basis for restriction was a posteriori lack of unity, the examiner arguing that Viljakainen disclosed the only feature that linked all of the groups and thus the only feature that could qualify as a "special technical feature" unifying the groups.

We note that no prior art-based rejections have ever been made in this case, and that claim 15 has been deemed allowable.

In the election with traverse, Applicants characterized the rationale of the restriction as being that Viljakainen anticipated claim 1. The January 7, 2009 action explained that the Examiner did not assert that Viljakainen anticipated claim

1, only that Viljakainen disclosed the aforementioned feature.

In our May 4, 2009 paper, we pointed out:

All claims are dependent, directly or indirectly, on claim 1¹. Hence all claims are linked by all the features of claim 1, not just the malolactic fermentation feature ("straw man").

Unity can be established by "one or more of the same or corresponding 'special technical features'". PCT Admin. Instructions, Annex B (b).

It follows that unity exists and the withdrawn claims should be rejoined.

The Examiner failed to establish that the recited combination of features provided by claim 1, and necessarily shared by all dependent claims, was either anticipated by Viljakainen or obvious over Viljakainen. If the combination of features was neither anticipated nor obvious, then it defines a contribution over the prior art and thus satisfies PCT requirements for unity.

In the Examiner's most recent analysis, he says:

Regarding argument 1, applicant correctly states that "a claim which is not anticipated can still be obvious and thereby lack a special technical feature". However, whether or not a *claim* is anticipated or obvious is not the standard for determining unity. According to PCT Rule 13.2, "Where a group of inventions is claimed in one and the same international application, the requirement of unit of invention referred to in **Rule 13.1** shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art". Note

¹ Claim 31 was then dependent on cancelled claim 30, which had been dependent, indirectly, on claim 1.

that the inventions must share a technical feature. It is whether or not this shared technical feature defines a contribution over the art that determines lack of unity, not whether claim 1 is anticipated or made obvious. There is only one feature that links all of the inventions found in this application, and that is a microbial organism that is capable of fermenting at least one fermentable compound. Since there is nothing more that links the inventions, nothing more must be disclosed by the prior art to break unity. The other limitations of claim 1 are not relevant to a discussion of unity because *they are not shared by all of the claimed inventions.*

The examiner is correct that the standard is whether the inventions as claimed define something in common that is a contribution over the prior art, but it is clear that the PCT concept of a "contribution over the prior art" is essentially equivalent to the US concept of "novel and non-obvious" and the European concept of "novel and with inventive step²", and that such a contribution can be established by a combination of features (PCT rule 13.1 refers to the claimed inventions "considered a whole" and 13.2 to "one or more... special technical features".) It is also clear that all of the withdrawn claims enjoy the same combination of features as claim 1 because they are directly or indirectly dependent on claim 1. The examiner cannot arbitrarily pick just one feature of claim 1 and say that since it is disclosed by Viljakainen (itself never relied on for a prior art rejection by the PTO), there is a lack of unity.

Both the January 7, 2009 and the present August 13, 2009 actions rejected claim 1 only on non-art grounds, thus impliedly admitting that claim 1 as a whole defined a contribution over the art.

Pursuant to PCT Administrative Instructions, Annex B, para.

² This is made explicit by the PCT International Search and Preliminary Examination Guidelines, §10.05.

(e), the examiner should have rejoined all method of use claims that were directly or indirectly dependent on claim 1, i.e., method of making claims 50, 51-52, and method of use claims 16, 18-26, 29, 31, 32, 34, 35, 37, 38, 40-42, 55, 58, 59 (underlined claims are directly dependent on claim 1).

Hence, the present petition against restriction should be granted.

2. Conditional Petition to Vacate

On condition that the petition against restriction is granted at least in part, we petition for supervisory review, under 1.181, and urge that in consequence of that review, the last action should be vacated, and finality should be withdrawn.

As previously explained, the actions of January 7, 2009 and August 13, 2009 rejected claim 1 only on non-art grounds and hence should have rejoined all withdrawn claims that were directly or indirectly dependent on claim 1.

Since the examiner failed to do so, and thereby failed to act on the merits of those claims, it follows that both actions were incomplete within the meaning of 37 CFR 1.104(b). Hence, the instant action should either be vacated, or supplemented with a reset period for response. Moreover, finality should be withdrawn immediately since applicants have not received the first action on the merits of those claims, and the examiner instructed that the first action considering those claims not be made final.

3. Miscellaneous

We note for the benefit of the SPRE and the examiner that we will shortly file an amendment that inter alia cancels the withdrawn "activation solution" claims 63-66 and 68-73, and amends "dry activation composition" claims 74-76, 79-82, 84-88, 90-93 to be dependent directly or indirectly on claim 1.

We have already explained why the final rejection should be vacated and further action be non-final. If so, the

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aforementioned amendment should be entered as of right, and the "dry activation composition" claims then rejoined under PCT Administration Instructions, Annex B, para (c), as those composition claims have a combination/subcombination relationship to claim 1.

Rejoinder of the composition claims would in turn trigger rejoinder of the dependent method-of-use claims 94, 95, 98-100.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: 

Iver P. Cooper
Reg. No. 28,005

624 Ninth Street, N.W.
Washington, D.C. 20001
Telephone: (202) 628-5197
Facsimile: (202) 737-3528
IPC:lms
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